

claimed invention is not disclosed such that one of ordinary skill in the art would recognize its existence, and therefore, the claimed invention is not anticipated by the cited reference. *ATD Corp. v. Lydall Inc.*, 48 USPQ2d 1321, 1328 (CAFC 1988) (none of cited prior art references, disclosing multilayer insulation, anticipated claims for embossed insulating layers and compressed heat sink layers).

Applicants have amended Claims 1 and 25 such that the present invention is a mascara composition that contains a plant extract prepared using the whole unfiltered fruit or vegetable. Support for this amendment is found in the present specification at page 3, lines 24 to 32. In the present specification at page 3, lines 26 to 27, the plant extract is specifically described as being seedless but otherwise is substantially unfiltered. No purifying process is conducted to separate the components of the fruit or vegetable extract. As such, the unfiltered plant extract of the present invention contains the whole pulp and skin of the plant. Below, Applicants demonstrate that the Pastour reference, cited by the Examiner, does not disclose a composition containing a seedless but substantially unfiltered plant extract.

The Pastour reference relates to an emulsion composition comprising a silicone, a gelling agent, and an emulsifying agent. Further, the Examiner finds that the Pastour compositions can also contain active ingredients such as plant extracts in an amount of 1 to 15 percent. However, it is the active principles derived from the plant extract that is present in an amount of 1 to 15 percent, not the plant extract itself (used to isolate the active principle). Further, at column 6, lines 3 to 7, the reference made to a plant extract in the Pastour reference is to produce an active principle, or at column 6, lines 8 to 9, to produce a filler. Similarly, the vegetable oils disclosed in the Pastour reference at column 5, lines 7 to 13, are separated from the vegetable. The Pastour reference merely discloses the source of extraction, i.e., the plant extract used to separate the oil, active principle or filler. Moreover, at column 5, line 65 to column 6, line 5, and in Example 1, the Pastour reference discloses that the actives and fillers are contained in the aqueous phase. However, unlike the Pastour reference, the present invention incorporates the unfiltered plant extract in the silicone oil of its mascara compositions. Although the Pastour reference teaches using a plant extract to yield the oil, active or filler, the Pastour reference does not disclose the whole unfiltered plant extract as an ingredient in its compositions.

In addition, Claim 25 of the present invention describes a mascara composition comprising a plant extract dispersed in a volatile silicone oil, as well as an antistatic component, a non-plant fiber component, and a natural plant fiber component. The components of the present invention as described in Claims 25 to 30 are not disclosed by the Pastour reference. Therefore, the Pastour reference does not anticipate the present invention, and Applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn.

## II. Unobviousness

The Examiner asserts that the Pastour reference also renders the present invention obvious. As mentioned above, Applicants have amended Claims 1 and 25 to describe the unfiltered plant extract in the mascara of the present invention. A *prima facie* case cannot be made if there is no teaching or suggestion of the subject matter of the claimed invention. When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Brouwer*, 37 USPQ2d 1663, 1666 (CAFC 1995)(citing *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)). There must be some teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to make the present invention. *ATD Corp. v. Lydall Inc.*, 48 USPQ2d 1321, 1329 (CAFC 1998)(citations omitted).

The Pastour reference fails to teach or suggest a composition containing the unseparated plant extract of the present invention. As mentioned above, the Pastour compositions contain oils, actives and fillers separated from the plant extract. However, the present invention incorporates in its mascara compositions the unseparated plant extract, and it is surprisingly not tacky. Typically, unfiltered natural ingredients contain sugars and starches that one of ordinary skill in the art would expect to make the mascara tacky. This is undesirable because the mascara is hard to apply and feels uncomfortable on the lashes. To remedy this problem, one known solution, as taught in the Pastour reference, is to separate individual components (e.g., oil, actives and fillers) out of the plant extract that are desirable. It has not been taught or suggested in the Pastour reference, however, to use the whole unfiltered plant extract in its compositions, as in the compositions of the present invention. Because the Pastour reference does not teach or suggest a composition containing an unfiltered plant extract, this reference fails to render the present invention obvious.

The combination of the Pastour reference with EP 781 544 issued to Tanabe et al. (the Tanabe reference) is further believed, by the Examiner, to render Claims 1, 4 to 6, and 26 to 30 of the present invention unpatentable under 35 U.S.C. §103(a). Although the Examiner notes that the Pastour reference fails to teach a fruit extract, the Examiner asserts that one of ordinary skill in the art would have been motivated to use the fruit extract of the Tanabe reference in the compositions of the Pastour compositions. However, the Tanabe reference fails to remedy the defect of the Pastour reference because both alone and, therefore, in combination with the Pastour reference, a composition containing an unfiltered plant extract is not taught or suggested.

A polyphenol derived from the fruit of Rosaceae is taught in the Tanabe reference, and specifically at page 4, lines 13 to 17, the Tanabe reference teaches that the polyphenol is derived from fruits of the Rosaceae by different purification methods. However, regardless of the purification process used, the polyphenol is separated from the fruit extract. Therefore, the Tanabe reference fails to teach or suggest the unfiltered fruit extract of the present invention. The unfiltered plant extract provides a natural fiber component to the mascara that thickens and lengthens lashes, as described in the present invention at page 4, lines 27 to 30. This function is not taught or suggested by the cited references. In combination with the previously discussed Pastour reference, the two cited references fail to render a *prima facie* case of obviousness because neither reference teaches or suggests a composition containing an unfiltered plant extract, as described in the amended claims of the present invention.

Even if a *prima facie* case of obviousness can be made, the surprising ability of the present invention to incorporate the unfiltered plant extract in a mascara that is non-tacky is sufficient to rebut the case, and thus, the present invention is non-obvious. A *prima facie* case of obviousness can be overcome by “unexpected results,” *i.e.*, showing that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the art would have found surprising or unexpected. *In re Soni*, 34 USPQ2d 1684, 1687 (CAFC 1995); *In re Piasecki*, 223 USPQ 785, 788 (CAFC 1984).

As previously mentioned, one of ordinary skill in the art would expect an unfiltered plant extract in a mascara to be tacky. It is hard to apply a gummy mascara to the lashes. Once applied, the mascara is uncomfortable because it does not dry easily and because it can cause the upper and

lower lashes to stick to one another, when it finally does dry. However, as provided in the present specification at page 8, lines 23 to 25, the mascara of the present invention surprisingly and unexpectedly performs the same as or better than conventional mascaras. Further, as described in the present specification at page 4, lines 27 to 30, the unfiltered plant extract provides a natural fiber component to the mascara that enhances the thickness and length of the eyelashes. Therefore, Applicants submit, that as amended, the claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because none of the cited references teaches or suggests a composition containing an unfiltered plant extract, and because the mascara is surprisingly and unexpectedly non-tacky. Thus, Applicants request that this rejection be withdrawn.

#### MISCELLANEOUS

An Information Disclosure Statement dated June 2, 1999 was previously filed. Enclosed herewith is a Supplemental Information Disclosure Statement for four references each of which are being submitted not more than three months after the date each of the references was cited in a communication from a foreign patent office in a counterpart foreign application pursuant to 37 C.F.R. 1.97(e). Applicants believe that no fee is due, however, if there is any fee due, please charge it to Deposit Account No. 05-1320.

#### CONCLUSION

Applicants believe that, as amended, the present claims are patentable over the cited prior art references. Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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